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IN THE  
**Supreme Court of the United States**  
OCTOBER TERM, 1945  
No. 1241

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THE KAR ENGINEERING COMPANY, INC.,  
*Petitioner,*

VS.

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BROWN & SHARPE MANUFACTURING COMPANY and  
JAMES NEILL & Co. (SHEFFIELD), LIMITED,  
*Respondents.*

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**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE FIRST CIRCUIT AND BRIEF IN SUPPORT  
THEREOF**

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THOMAS J. BYRNE,  
CLIFFORD H. BYRNES,  
*Counsel for Petitioner.*

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THE KAR ENGINEERING COMPANY, INC.,  
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BROWN & SHARPE MANUFACTURING COM-  
PANY and JAMES NEILL & Co. (SHEFFIELD),  
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*Respondents.*

**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE FIRST CIRCUIT**

*To the Honorable, the Chief Justice and Associate Justices  
of the Supreme Court of the United States:*

Petitioner, The Kar Engineering Company, Inc., respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the First Circuit to review the judgment of that court which was entered on the 14th day of March, 1946 (R. 447).

**Summary and Short Statement of  
Matters Involved**

This civil action was brought by respondents Brown & Sharpe Manufacturing Company, a Rhode Island corporation, which has its principal place of business at Provi-

dence, Rhode Island, and James Neill & Co. (Sheffield), Limited, a British Limited Company, against petitioner, The Kar Engineering Company, Inc., a Massachusetts corporation, which has its principal place of business at Great Barrington, Massachusetts (R. 2).

The action was brought for alleged infringement upon letters patent of the United States No. 2,053,177 (R. 155) granted on September 1, 1936 to respondent James Neill & Co. (Sheffield), Limited, as assignee of applicant William Leslie Bower for Work Holder—a chuck in which magnetic articles are held in position by magnetic force. Claims numbered 1, 5, 7 and 14 of the Bower patent are charged to be infringed by petitioner.

Respondent Brown & Sharpe Manufacturing Company is an exclusive licensee under said patent (R. 159, 160).

The District Court of the United States for the District of Massachusetts determined that the Bower patent is invalid as to said claims and directed that the complaint be dismissed (R. 10-21). It did not pass upon the issue of alleged infringement (R. 21).

On appeal of respondents the United States Circuit Court of Appeals for the First Circuit reversed the judgment of the District Court and held said claims of the Bower patent to be valid and also infringed.

A petition for rehearing as to the holding of infringement was presented to the Court of Appeals by petitioner but it was denied without opinion by order entered on April 16, 1946 (R. 447).

The Court of Appeals (a) concluded that this Court has not required a higher standard for invention than was required for a long period of time and sustained the Bower patent which is for a purported improvement within the skill of mechanics in the art, (b) made a ruling as to the issue of infringement and held that infringement exists even though this issue had not been passed upon by the District Court and (c) failed to enforce limitations embodied in claims in suit of the Bower patent during prosecution in the United States Patent Office and accorded an



interpretation of the said claims of the Bower patent which will preclude proper competition and manufacture and sale to the public of permanent magnetic chucks which would have resulted had the limitations in said claims been enforced in deciding the issues of infringement.

### **Jurisdiction to Review Judgment in Question**

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Acts of February 13, 1925 and March 8, 1934 (28 U. S. C. A. § 347) and under 28 U. S. C. A. § 35 for, "within three months" from the date of entry of the judgment, this petition will have been presented.

### **The Questions Presented**

Review of the judgment of the Court of Appeals is sought. The following questions are presented:

1. May the Court of Appeals disregard determination of this Court requiring a high standard for invention for the grant of a valid patent and lawfully sustain a patent for a purported invention which is for an improvement that is clearly within the skill of mechanics in the art?

2. May the Court of Appeals disregard limitations imposed or accepted during the prosecution of an application for a patent in disregard of decisions of this Court and accord scope to claims of a patent without regard to such imposed limitations?

3. May the Court of Appeals pass upon and determine an issue of infringement of claims of a patent when such issue of infringement was not considered, determined or made the basis of findings of fact or conclusions of law by the District Court in which the action was tried.

### Reasons Relied On for the Allowance of the Writ

The discretionary power of this Court is invoked upon the following grounds:

The determination of the Court of Appeals is at variance with the decision of this Court in *Cuno Engineering Corporation v. Automatic Devices Corporation*, 314 U. S. 84.

The determination of the Court of Appeals is also contrary to the decisions of the United States Circuit Court of Appeals for the Second Circuit in *Picard v. United Aircraft Corporation*, 128 F. (2d) 632, 636.

The Court of Appeals, because of the divergence of its decision from decision with this Court, determined that the Bower patent is valid but which, according to the law as laid down by this Court, is not properly patentable but is solely for a device which is the result of the skill of mechanics in the art to which it appertains.

The divergence of the decision of the Court of Appeals with the decisions of this Court and of the United States Circuit Court of Appeals for the Second Circuit should be resolved by this Court in the interest of the public.

In determining that claims 1, 5, 7 and 14 of the Bower patent are infringed by petitioner the Court of Appeals did not enforce limitations embodied in said claims during prosecution of the application in the Patent Office, which course is contrary to the law stated by this Court in *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, at 443-4, and *Exhibit Supply Co. v. Ace Patents Corporation*, 315 U. S. 126, at 136-7.

The course of the Court of Appeals in determining the issue of infringement of the Bower patent, which was not decided by the District Court, was improper. It should have remanded the action to the District Court with directions to determine the issue of infringement and to make suitable findings of fact and conclusions of law with

respect thereto. The decision of the Court of Appeals on the issue of infringement resulted in depriving petitioner of its right to have this issue decided by the District Court and reviewed by the Court of Appeals.

The determination of the District Court with respect to validity and infringement of claims 1, 5, 7 and 14 of the Bower patent No. 2,053,177 is contrary to law and will result in preventing manufacture and sale of permanent magnetic chucks and fair and lawful competition therein.

WHEREFORE, it is respectfully submitted that this petition for a writ of certiorari should be granted.

THOMAS J. BYRNE,  
CLIFFORD H. BYRNES,  
*Counsel for Petitioner.*

Dated, May 17, 1946.